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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,258	01/30/2006	Toru Yano	8007-1105	1688

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YOUNG & THOMPSON
745 SOUTH 23RD STREET
2ND FLOOR
ARLINGTON, VA 22202

EXAMINER

ANGEBRANDT, MARTIN J

ART UNIT	PAPER NUMBER
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1756

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07/11/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/566,258	Applicant(s) YANO ET AL.	
	Examiner Martin J. Angebrannt	Art Unit 1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The response of the applicant has been read and given careful consideration. The applicant has perfected priority and is accorded the date of August 7, 2003. Responses to the argument of the applicant are presented after the first rejection to which they are directed. The applicant has filed a terminal disclaimer for 10/973,444 and 10/899027.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 should insert - - and when one of the other paired group is are not a pair of benzyl groups, then these each are an alkyl group of 1 to 4 carbon atoms or are connected together to form a 3 to 6 member ring - - . This makes it clearly an alternative and expresses the conditions for it.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of (Tominaga et al. JP 2000-108510, Hamada et al. JP 2000-168233 or Tominaga et al. 2000-289335), in view of Nagatani et al. JP 10-278426, JPO Abstract of JP 03-224793 and Sakai et al. JP 58-021746.

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Tominaga et al. JP 2000-108510 (machine translation attached) teaches optical recording media using the indoleneic trimethine cyanine dyes of formula I, where A may be phenyl and X may be methylene to form a benzyl moiety. Further, this may be substituted by halogen, alkyl, alkenyl, alkenoxy, or alkoxy. (abstract and [0018-0021]. See dye 3 has N- ethylphenyl substituents. The media have high photostability, preservation stability and solubility (abstract and [0015]).

Hamada et al. JP 2000-168233 (machine translation attached) teaches optical recording media using the indoleneic trimethine cyanine dyes of formula I, where Y1-Y3 may be formula III, where R4 is phenyl and l is one, m is zero to form a benzyl moiety. Further, this may be substituted by halogen, alkyl, alkenyl, alkenoxy, or alkoxy. (abstract and [0018-0021]. See dyes 7 and 10 which have N- ethylphenyl substituents. The resulting media have high stability and reliability (abstract and [0011])

Tominaga et al. 2000-289335 (machine translation attached) teaches optical recording media using the indoleneic trimethine cyanine dyes of formula I, where R2 may be phenyl, l may be zero and R1 may be methylene to form a benzyl moiety. Further, this may be substituted by nitro, cyano, halogen, alkyl, alkoxy or the like. (abstract and [0018-0021]. See dye 3, which has N- ethylphenyl substituents. The media have high photostability, preservation stability and solubility (abstract and [0015]).

Nagatani et al. JP 10-278426 (machine translation provided) teaches optical recording media with the indoleneic trimethine cyanine dyes of formula 1 where R1-R6 can be hydrogen, alkoxy, alkoxy, alkylhydroxy, aralkyl, alkenyl, alkylcarbonyl or alkylsulfonyl. (abstract and 0011))

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JPO Abstract of JP 03-224793 (but not the document itself) teaches that R1-3 can be C1-8 alkyl, phenyl or benzyl. (© is 1991).

Sakai et al. JP 58-021746 teaches a cyanine analog where the terminal moieties are indolenic. Dyes H-11 and H-12 (page 3) show the benzyl moieties as N substituents. Dye H-10 shows where the benzyl moieties are bound to the carbon adjacent to the linkage binding the two terminal moieties.

It would have been obvious to one of ordinary skill in the art to modify dye 3 of Tominaga et al. JP 2000-108510, dyes 7 or 10 of Hamada et al. JP 2000-168233 or dye 3 of Tominaga et al. 2000-289335 by forming the benzyl analogs where two benzyl moieties are bound to the carbon of the indolene ring in place of an alkyl moiety to form the dyes of the claims and to use these in optical recording media with a reasonable expectation of realizing the benefits ascribed to these dyes by Tominaga et al. JP 2000-108510, Hamada et al. JP 2000-168233 108510 or Tominaga et al. 2000-289335 based upon the known use of aralkyl moieties in both locations as evidenced by Nagatani et al. JP 10-278426 and specifically benzyl moieties as disclosed in JPO Abstract of JP 03-224793 and the indolenic dyes of Sakai et al. JP 58-021746 which bear paired benzyl moieties.

The applicant is correct that the dye is not exemplified. The applicant argues that Nagatani et al. teaches away from the claimed invention, While there is a teaching of a preference to alkyl moieties, there is no teaching that the aralkyl moieties do not work. The applicant refers to a machine translation of JP 03-224793, but there is no machine translation in the record or for that matter available as it was published before 1993. Only the Derwent Abstract is in English. The applicant argues as if the abstract is not a document itself. Although

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the abstract is not supported by the document, it can motivate one, particularly one not reading Japanese, to make changes. While JP 58-021746 relates to hydrazones, these are clearly structurally related to the indoleneic cyanine dyes, specifically the indolene terminal moieties bound by a chain with alternating double bonds and can serve to establish that the formation of indolenic terminal moieties was known and serves to establish a reasonable expectation of success in being able to form indolenic cyanine dyes with paired benzyl moieties.

The applicant argues that there is no motivation, but this appears in the primary references, which are not treated in the arguments thoroughly. Tominaga et al. JP 2000-289335 [0057-0062] and Tominaga et al. JP 2000-108510 [0054-0062] teach the improvements over alkyl substituted indoleneic dyes. The showing of the applicant with respect to the dyes illustrated in table 1 of the instant specification do not go beyond this and further is limited to hexafluorophosphate anions, which is an unrecited feature. The rejection stands.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1 and 3-5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 11/257325 (US 2006/0110566). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims embrace the case where the R2 and R3 of formula 2 and/or formula 1 are benzyl moieties.

The claims do not specify that the alkyl groups are unsubstituted and therefore the claims are held to embrace the case where methyl (C1) is substituted by phenyl.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Neither, the terminal disclaimer or the arguments address this rejection.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

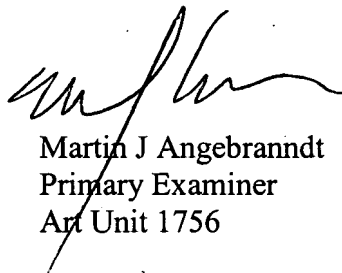
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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J. Angebranndt whose telephone number is 571-272-1378.

The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Martin J Angebranndt
Primary Examiner
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07/9/2007